

### **REMARKS**

Claims 1 and 3-10 are pending in this application, of which claims 1, 5 and 8 have been amended. Claims 9 and 10 has been added.

(1) Claims 1 and 3-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over DE Patent No. 3,841,203 to Obermayer et al. in view of U.S. Patent No. 5,263,444 to Prior et al. and further in view of U.S. Patent No. 5,934,686 to Ottenschläger.

(i) In the invention of Ottenschläger, the objective is to provide an effective seal directly at the corner of the top sealing rim of the oil pan extending substantially horizontal, and the end face sealing rim of the oil pan extending substantially vertical (col. 1, lines 31-36 and 42-43). Although Ottenschläger teaches that grooves are provided in the sealing rims of the first wall element or of the second wall element, or both (col. 2, lines 9-10), the grooves should be provided on two planes 9, 10 such that the two grooves in the two sealing rims of the first wall element are offset and askew relative to one another, so that they do not intersect, are not parallel, and do not lie in the same plane (col.2, lines 16-20). In the offset configuration of Ottenschläger, the seal member is not deflected around the corner in a single plane which extends perpendicularly or orthogonally relative to the two sealing surfaces, and the pressing forces applied to the seal member are substantially locally perpendicular to the extension direction of the seal member at all locations, both in the offset portion of the seal member arranged along the intersection edge, as well as in the major portions of the seal member (col. 2, lines 40-51). This configuration makes complete, effective and reliable seal even in the area of the intersection edge,

because there is a counter-surface backing up the seal member against the sealing compressive forces at all locations (col. 2, lines 52-56).

The Examiner seems to consider that one of the grooves 6, 7 of Ottenschläger can be applicable to the receiving groove 5 of Obermayer. However, the teaching of Ottenschläger is to provide the grooves on two planes 9, 10 with an offset portion in a right angle relationship to one another (col.2, lines 16-20). Thus, removing only one groove from the two grooves of Ottenschläger renders the teachings of Ottenschläger inoperable. If the reference apparatus were modified, it would be rendered inoperable for its intended purpose. *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125 (Fed Cir. 1984).

Thus, Ottenschläger cannot be combined with Obermayer by making the teaching of Ottenschläger inoperable.

(ii) Claims 1 and 5 have been amended, and claim 9 have been added, whose basis is found at Fig. 7, where the gasket is shown as numeral 85. In claims 1, 5 and 9, the amendment has made it clear that the gasket has a sheet form, and that the gasket comes into close contact with the upper end faces of the enlarged end portions. Also, in claim 9, the amendment has made it clear that the lower surface of the gasket comes into contact with the first enlarged end portion or the second enlarged end portion.

In the present invention, the upper surface of the gasket contacts the flat lower end face of the cylinder, and the lower surface of the gasket contacts the crankcase as well as the upper end faces of the enlarged end portions. By using the flat gasket in such configuration, the assembling process becomes easy.

On the other hand, Obermayer's gasket 10 is not shaped into a sheet, but has a cup-like recess 12 through which the toroidal sealing ring 6 is passed. The lower surface of the Obermayer's gasket does not contact the end portion of the toroidal sealing ring 6.

Thus, claims 1, 5 and 9, as amended, cannot be obtained even if combining the references.

(iii) In Obermayer, the ring shaped gasket 10 is located between the mating faces of cylinder 4 and crankcase 1. The toroidal sealing ring 6 received into the groove 5 is located between the crankcase parts 1', 1''. At the mating portion among the cylinder 4 and crankcase parts 1', 1'', the cup-like recess 12 of the gasket 10 is located. Thus, in Obermayer, the cup-like recess 12 of the gasket 10 serves to seal among the cylinder 4 and the crankcase parts 1', 1'', and the end portion of the toroidal sealing ring 6, as shown in Fig. 4, does not serve as a sealing. It should be noted that there is a space between the upper end surface of the toroidal sealing ring 6 and the upper wall in the recess 7 as shown in Fig. 4. The toroidal sealing ring 6 is not intended to serve as a sealing for the cylinder 4. The toroidal sealing ring 6 only serves as a sealing for the crankcase parts 1', 1''.

On the other hand, the bar-shaped or U-shaped seal member of the present invention has the claimed enlarged end portions, which come into contact with the lower surface of the flat gasket, so as to serve to seal between the cylinder block and the crankcase (first and second cases).

Even if Prior teaches a bar-shaped seal member having an enlarged end portion, there is no further motivation in Obermayer to modify the end portion of the toroidal sealing ring 6 coming into close contact with the flat gasket disposed at the lower end face of the cylinder block. The teaching of Obermayer is that the toroidal sealing ring 6 does not come into contact with the cylinder. Thus, the invention of claims 1, 5 and 9 is not obvious in this respect.

(2) The basis of claim 10 is found at claim 8.

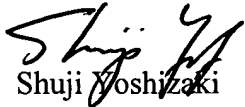
(3) In view of the aforementioned amendments and accompanying remarks, Applicants submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

Submission under 37 C.F.R. §1.114  
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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
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